

## REMARKS/ARGUMENTS

### Claim Rejections

35 U.S.C. § 112

The Examiner has said:

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, the Applicant is required to clarify to what the claim is intended to be drawn to, i.e., either the medical port alone or the combination of the medical port and the resuscitator having a collapsible bag. The Applicant sets forth the combination of the medical port and the collapsible bag when describing the “tube having a first aperture attached to and communicating with a second end of a collapsible bag of a resuscitator”, which is inconsistent with the preamble, that sets for the subcombination of a medical port **for** an emergency safety resuscitator having a collapsible bag. Applicant is required to make the language of the claims consistent with the intent of the claims. It should also be noted that in considering the claims on the merits, the Examiner will consider the claims as drawn to the combination.

Although the disclosure covers both the referenced combination and the referenced subcombination, Applicant has chosen to proceed with claims drawn to the subcombination.]

Claims 1, 2, 7, and 12 have been canceled.

Claims 3, 8, 9, and 10 have been drafted to include the limitations of the claims upon which they depend with such limitations rewritten to respond to the Examiner’s concerns and clearly indicate that they are drawn to the subcombination of a medical port **for** an emergency safety resuscitator having a collapsible bag.

Next the Examiner observes:

There is a lack of antecedent basis for the following limitations:

- Claim 1, line 5, “the second end”

- Claim 3, lines 3-4, “the inside”
- Claim 10, lines 3-4, “the inside”

Correction is required.

As noted above, claim 1 has been canceled. In claims 3, 8, 9, and 10, a limitation has been included indicating that the tube has an inside.

### 35 U.S.C. § 102

The Examiner continues:

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson (US 4106502).

**As to claim 1**, Wilson teaches a medical port for an emergency safety resuscitator having a collapsible bag **50** with an outlet, which comprises an adapter **53** having a first end available for attachment to and communication with a collapsible bag of a resuscitator and also having a second end (**See Fig. 7**); a tube **2** having a first aperture **14** attached to and communicating with a second end of a collapsible bag of a resuscitator, a second aperture **42**, and a third aperture (**See Fig. 1**) available for connection to a mask or an endotracheal tube.

**As to claim 12**, Wilson teaches a medical port wherein the adapter and tube are constructed of rigid clear plastic (**See Col. 1, lines 50-54**).

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Coates et al (US 5762063).

**As to claim 1**, Coates teaches a medical port for an emergency safety resuscitator having a collapsible bag **22** with an outlet, which comprises an adapter (the end connected to element **28**) having a first end available for attachment to and communication with a collapsible bag of a resuscitator and also having a second end (**See Fig. 1, second end connects to 28**); a tube **28** having a first aperture attached to and communicating with a second end of a collapsible bag of a resuscitator, a second aperture **12**, and a third aperture **14** available for connection to a mask or an endotracheal tube.

**As to claim 2**, Coates teaches a medical port further comprising a self-sealing membrane releasably covering the second aperture of the tube (**See Col. 5, lines 19-50, specifically lines 40-42**).

Although Applicant respectfully disagrees with the characterization of the Wilson patent (United States patent no. 4,106,502), claims 1, 2, and 12 have been canceled.

35 U.S.C. § 103

Then the Examiner states:

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coates et al (US 5762063) in view of Wilson (US 4103502).

**As to claim 7**, Coates teaches essentially all of the limitations except for the adapter and tube being constructed of a clear plastic. However, Wilson does teach the use of clear plastic for internal viewing of the device when in use. Therefore, it would be obvious to one of ordinary skill in the art to modify the plastic of Coates to a clear plastic so that the device can be viewed internally during use.

Claim 7 has been canceled.

The Examiner further declares:

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coates et al (US 5762063) in view of Wilson (US 4103502) further in view of Rosenblatt (US 4950247).

**As to claim 8**, the combination of Coates and Wilson teach essentially all of the limitations except for wherein the self-sealing member is siliconized. However, Rosenblatt does teach the use of silicon since it is a material that has memory so that any element formed from silicon would return to its original shape if that element is deformed without requiring the use of a spring or other elastic material to bring the element back to its original shape. Therefore, it would be obvious to one of ordinary skill in the art to make the self-sealing member of Coates from silicon so that it can return to its original shape after being deformed.

Rosenblatt (United States patent no. 4,950,247) utilizes silicon rubber in a bellows for the purpose stated by the Examiner. Applicant, however, respectfully suggests that acting like a spring is the function of a bellows but is a completely different function from having a material which has been punctured with a needle seal itself.

Consequently, Applicant respectfully submits that claim 8 is patentable and not unpatentable over Coates et al. in view of Wilson.

The Examiner then provides:

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coates et al (US 5762063) in view of Rosenblatt (US 4950247).

As to claim 9, Coates teaches essentially all of the limitations except for wherein the self-sealing member is siliconized. However, Rosenblatt does teach the use of silicon since it is a material that has memory so that any element formed from silicon would return to its original shape if that element is deformed without requiring the use of a spring or other elastic material to bring the element back to its original shape. Therefore, it would be obvious to one of ordinary skill in the art to make the self-sealing member of Coates from silicon so that it can return to its original shape after being deformed.

For the same reasons as stated above with respect to claim 9, Applicant respectfully submits that claim 9 is patentable and not unpatentable over Coates et al. in view of Rosenblatt.

#### Double Patenting

Finally, the Examiner explains:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6062217. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims which are more specific embodiment anticipate the application claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claims 4 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6062217 in view of Wilson (US 4106502). US Patent 6062217 to Gray teaches essentially all of the limitations except for wherein the adapter and tube are made of a rigid clear plastic. However, Wilson does teach the use of rigid clear plastic for compact size, economical cost of fabrication, and internal visibility. Therefore, it would be obvious to one of ordinary skill in the art to make the adapter and tube of Gray from a rigid clear plastic for compact size, economical cost of fabrication, and internal visibility.

Claims 5 and 67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6062217 in view of Wilson (US 4106502) and further in view of Rosenblatt. US Patent 6062217 to Gray teaches essentially all of the limitations except for wherein the adapter and tube are made of a rigid clear plastic. However, Wilson does teach the use of rigid clear plastic for compact size, economical cost of fabrication, and internal visibility. Therefore, it would be obvious to one of ordinary skill in the art to make the adapter and tube of Gray from a rigid clear plastic for compact size, economical cost of fabrication, and internal visibility. Also, Gray fails to specifically teach the self-sealing member being siliconized. However, Rosenblatt does teach the use of silicon since it is a material that has memory so that any element formed from silicon would return to its original shape if that element is deformed without requiring the use of a spring or other elastic material to bring the element back to its original shape. Therefore, it would be obvious to one of ordinary skill in the art to make the self-sealing member of Coates from silicon so that it can return to its original shape after being deformed.

Applicant has filed herewith a terminal disclaimer.

Applicant respectfully requests the Examiner to allow claims 3 through 6 and 8 through 11.

DATED this 8<sup>th</sup> day of August, 2003.

Respectfully,

David Scott Gray

By Thompson E. Fehr  
Thompson E. Fehr  
Attorney  
Registration No. 31353  
(801) 393-6292

Attorney's Address:

Suite 300  
Goldenwest Corporate Center  
5025 Adams Avenue  
Ogden, Utah 84403